

b.) Remarks

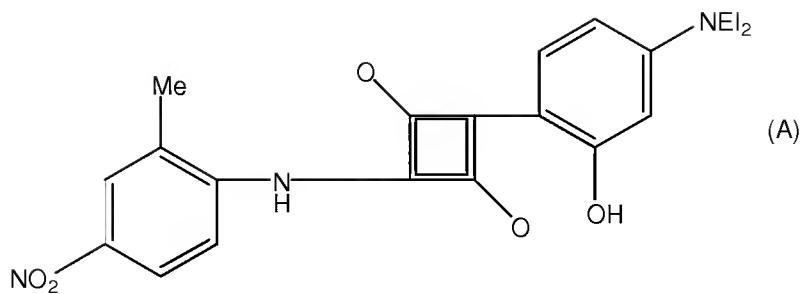
Claim 1 has been amended for better grammatical usage and new claims 12-14 are presented in order to more specifically recite various preferred embodiments of the present invention. Accordingly, no new matter has been added.

Claims 1 and 2 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement since the Examiner states Applicants have not reduced any compounds of formula 1a to practice. In response, Applicants respectfully wish to point out there are original claims and so provide their own written description. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 296 F.3d 1316 (Fed. Cir. 2002). Nonetheless, solely in order to reduce the issues and expedite prosecution, these claims have above been cancelled without prejudice. Accordingly, this rejection is mooted.

Claims 1 and 2 are rejected under 35 U.S.C. §112, first and second paragraphs, as failing to be enabled and as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection too is mooted by the foregoing cancellation of claims 1 and 2.

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shimizu (WO 01/44375, equivalent to U.S. Patent No. 6,599,605), in view of Bloor (*Can. J. Chem.*, Vol. 39 (1961) 2256-61) and Davis (*Int. J. Quant. Chem.*, Vol. 72 (1999) 463-71).

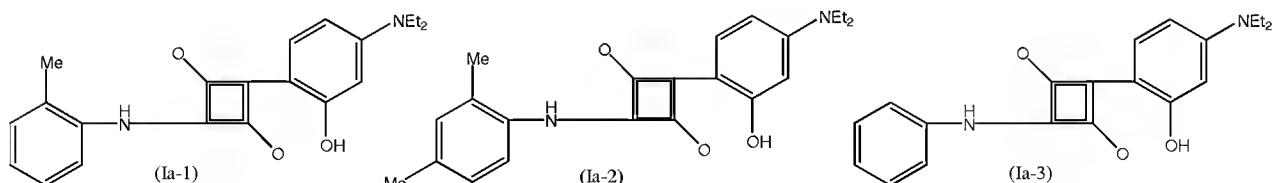
In support of the rejection, the Examiner states Shimizu teaches the compound:



Although this compound is not Applicants', the Examiner contends that Bloor and Davis "reliably predict" the effects of changing substituents therein.

Accordingly, in order to address the Examiner's concerns, Applicants have proceeded to prepare and conduct experiments comparing the solubilities in organic solvents of representative compounds of the present invention to those of Shimizu's compound. These experiments are recounted in the attached Declaration under Rule 132 of Dr. Motoharu Kinugasa.

As discussed in Dr. Kinugasa's Declaration, compounds (Ia-1), (Ia-2) and (Ia-3), according to the present invention were prepared to compound (A), the prior art compound taught by Shimizu



The solubilities of these four compounds was then evaluated in each of (i) 1,2-dimethoxyethane, (ii) methyl ethyl ketone and (iii) toluene.

As discussed in the attached Declaration, Applicants' compounds are, on the average, more than an order of magnitude more soluble in 1,2-dimethoxyethane¹, more than an order of magnitude more soluble in methyl ethyl ketone² and more than an order of magnitude more soluble in toluene³ than Shimizu's compound.

Those of ordinary skill readily appreciate that such advantage provides that the compounds of the present invention are more suitable for filter production by conventional solution processing such as spin coating. Advantages of using highly soluble compounds in an organic solvent include: (1) use of less amount of an coating solvent, thus making a filter production economically and environmentally favorable; (2) easy processing and the like.

Such advantages are not suggested in Shimizu even taken with Bloor and Davis.

In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 3 and 12-14 remain presented for continued prosecution.

¹ ((0.24 + 0.12 + 0.03)/3)0.01

² ((0.21 + 0.11 + 0.02)/3)0.01

³ ((0.02 + 0.02 + 0.001)/3)/0.001

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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